

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY SORENSEN

Appeal No. 2002-0334
Application No. 08/779,361

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 5 and 8. Claims 2, 3 and 7 have been canceled, claim 6 has been objected to, and claims 9-13 have been allowed.

We REVERSE.

BACKGROUND

The appellant's invention relates to a volatile corrosion inhibiting device for firearms. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cech	4,100,693	Jul. 18, 1978
Wolford	5,315,778	May 31, 1994

Claims 1, 4 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cech.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cech in view of Wolford.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 21) and the Supplemental Answer (Paper No. 25) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 9) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1:

A volatile corrosion inhibiting device for firearms comprising:

an inner sleeve;

an exterior sleeve sized to fit over the inner sleeve; and

means for dispensing volatile corrosion inhibiting materials disposed within the inner sleeve.

The examiner has rejected independent claim 1 and dependent claims 4 and 8 as being anticipated¹ by Cech. Among the limitations in claim 1 is “means for dispensing volatile corrosion inhibiting materials disposed within the inner sleeve,” which the examiner finds in the Answer (page 3) to be readable on element 14 of Cech. The appellant disagrees, arguing on pages 10 and 11 of the Brief that

the means employed by Cech does not disclose the means employed in the applicant's invention. In Cech, the corrosion resistant insert member is partially slipped into the jacket which allows a portion of the corrosion resistant member to remain permanently exposed. Additionally, the jacket in Cech does not serve any functional purpose relating to the corrosion resistant material. By contrast, in the applicant's invention, the core containing the volatile corrosion inhibitor material is completely inserted into the inner sleeve which is then covered by the exterior sleeve. Thus, the means for dispensing volatile corrosion inhibiting materials disposed within the inner sleeve in the applicant's invention is not disclosed in Cech.

¹Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

We interpret this argument to mean that the appellant is urging that this limitation is in "means plus function format," as permitted by 35 U.S.C. § 112, ¶ 6, and as such it must be interpreted to cover the structure disclosed in the specification and the equivalents thereof.² In construing a "means plus function" limitation a number of factors must be considered, including the language of the claim, the specification, and the prosecution history. Once such factors are weighed, the scope of the "means plus function" limitation can be determined. See United States v. Teletronics, Inc., 857 F.2d 778, 782, 8 USPQ2d 1217, 1220 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989).

In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989). Accordingly, in ascertaining that a "means-plus-

² As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

function" limitation is met by the prior art, an examiner must (1) determine that the prior art performs the identical function recited in the means limitation; (2) identify every structure described in the patent specification that corresponds to the claimed function;³ (3) identify the structure in the prior art that performs the claimed function; (4) determine if the structure in the prior art that performs the claimed function is the same as any structure described in the patent specification that corresponds to the claimed function; and if not (5) determine if the structure in the prior art that performs the claimed function is equivalent to any structure described in the patent specification that corresponds to the claimed function.

The Manual of Patent Examining Procedure (MPEP) § 2183 (Eighth Edition, Aug. 2001) now provides that if the examiner finds that a prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means plus function limitation, the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent.⁴ In the present case, the

³ Structure disclosed in the specification is corresponding structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc., 248 F.3d 1303, 1311, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001).

⁴ The four tests set forth in MPEP § 2183 for determining whether or not a prior art element is an equivalent to the corresponding element disclosed in the specification are (A) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification; (B) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art (continued...)

examiner did not perform the required “means-plus-function” analysis in arriving at the conclusion that claim 1 was anticipated by Cech, and as a result this panel of the Board remanded the application to the examiner to do so (Paper No. 22). In the response to the remand (Paper No. 25), the examiner states “while applicant does disclose a core containing the volatile corrosion inhibitor material that is inserted into the inner sleeve which is then covered by the exterior . . . it is not readily apparent from the specification that these structures would have been considered to be the means for dispensing” (page 3). While not precisely explained, it appears to us from paragraph (3) of page 3 of the response to the remand that the examiner has taken the position that Cech’s core of volatile material 14, jacket 13 with holes 15, and outer sleeve 16, while not the same as the structure disclosed by the appellant, is equivalent to the appellant’s disclosed structure because it performs the same function and therefore meets the terms of this “means-plus-function” recitation of structure in the claim. We do not agree with this conclusion.

From our perspective, the specification indicates that the structure disclosed by the appellant for dispensing volatile corrosion inhibiting material within the inner sleeve comprises (1) an inner sleeve having a base which approximates the size of the rim of a shell or cartridge and has a plurality of arms extending upwardly from the rim and

⁴(...continued)

for the corresponding element disclosed in the specification; (C) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification; and (D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification.

defining between the arms spaces through which a volatile corrosion inhibitor material vapor can be expelled, (2) an outer sleeve rotatably mounted around the base of the inner sleeve and having an open end that fits over the arms of the inner sleeve and slots which are equal to the size and number of the spaces between the arms in the inner sleeve, and (3) a volatile corrosion inhibiting material in essentially a columnar shape positioned in the inner sleeve. By means of this construction, rotating the outer sleeve with respect to the inner sleeve adjusts the amount of volatile corrosion inhibitor vapor released into the firearm by varying the relationship of the spaces in the inner sleeve and the slots in the outer sleeve and thus the size of the openings through which the vapors can pass. See pages 3, 4, 7 and 8 of the appellant's specification and Figures 2 and 3.

It is clear that the structure disclosed in Cech is not the same as that of the appellant, for the inner sleeve does not have arms defining spaces and the outer sleeve does not have slots. There is no mention in Cech of adjusting the amount of vapors allowed to emanate from the core of corrosion inhibiting material and, while it might be possible to do so, there is no teaching in the reference that the inner sleeve is rotatable with respect to the outer sleeve once it is installed in place either by contact with the inwardly extending annular shoulder 16 or by threaded connection (column 3, lines 40-58). Moreover, even if the inner sleeve were to be rotated with respect to the outer sleeve, the result would not be to adjust the amount of vapors dispersed to the firearm,

for the rotation would not alter the total area through which the vapors can escape, that is, the size or number of the holes.

Claim 1 states that there be a means “for dispensing volatile corrosion inhibiting materials disposed within the inner sleeve.” Cech performs this function. Cech does not, however, perform this function by structure identical to that disclosed by the appellant. Nor, in our view, can the structure disclosed by Cech be considered to be the equivalent of the structure described by the appellant in the specification, for it does not have the capability to adjust the amount of corrosion inhibiting vapors that are communicated from the material to the firearm, which is one of the objects of the appellant’s invention (specification, sentence bridging pages 2 and 3). In this regard, the examiner has not made findings in accordance with any one of the four tests set forth in detail in Section 2183 of the MPEP for determining whether or not a prior art element is an equivalent of the corresponding element disclosed in the appellant’s specification (see footnote 4, supra), nor provided evidence that would support an affirmative response to any of the them.

It therefore is our conclusion that the Cech structure is neither identical to nor the equivalent of the structure disclosed by the appellant as the “means for dispensing volatile corrosion inhibiting materials” This being the case, Cech does not disclose or teach all of the subject recited in claim 1, and thus is not anticipatory thereof. The rejection of claims 1, 4 and 8 is not sustained.

Claim 5 stands rejected as being obvious⁵ in view of the combined teachings of Cech and Wolford, the latter being cited for disclosing an O-ring in a cartridge for dispensing corrosion inhibiting material. Evaluating Cech in the light of 35 U.S.C. § 103 does not cause us to alter our conclusion that it falls short of teaching the means-plus-function structure recited in claim 1, from which claim 5 depends. Wolford does not alleviate the shortcomings explained above with regard to Cech, and we therefore are of the view that the combined teachings of Cech and Wolford fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 5, and we will not sustain this rejection.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

⁵The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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BASIL E. DEMEUR
KNECHTEL, DEMEUR & SAMLAN
130 S. OAK PARK AVE.
OAK PARK, IL 60302